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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,206	08/18/2000	Takayuki Hirabayashi	09792909-0398	7277

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EXAMINER

JONES, STEPHEN E

ART UNIT PAPER NUMBER

2817

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,206

Applicant(s)

HIRABAYASHI, TAKAYUKI

Examiner

Stephen E. Jones

Art Unit

2817

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 9-28 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 15-20 and 21-28 are directed to inventions that are independent or distinct from the invention originally claimed/elected for the following reasons:

The newly submitted claims 15-20 include a "mounted device" similar to the originally filed non-elected Claim 8. Claim 15 appears to more appropriately read on the non-elected species IX (Fig. 14).

Also, the newly submitted claims 21-28 are of a method of forming a circuit device including making changes to the earth conductor, whereas the originally elected product claims 1-5 do not require any changing of the earth conductor, because only the final product is patentable in an apparatus claim (i.e. in an apparatus claim the final product is what is patentable, and the method limitation in the apparatus claims indicating that the earth conductor is "changeable" is not given any patentable weight since this ability to change is not part of the permanent structure, e.g. a tuning screw is an adjustable part of an apparatus that is permanent).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-20 and 21-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 9 and 10, there does not appear to be any disclosure of how the "final product" is "changeable" so as to enable one to make or use the invention. In an apparatus claim only the final product is patentable. Applicant's claimed invention does not appear to include any permanent feature that is changeable or adjustable after the product has already been made.

Any arguments regarding this "enablement" rejection should include the location in the original specification where the enabling subject matter can be found.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 9 and 10, it is not clear what the applicant is intending to claim thus rendering the claim vague and indefinite. It does not appear that anything in

applicant's invention is changeable or enables change. Is applicant attempting to indicate that the pre-selected pattern formed in the earth conductor affects the frequency characteristic?

Regarding Claim 11, the phrase "the first layer" lacks antecedent basis and thus renders the claim indefinite.

Regarding Claim 12, the phrase "the second layer" lacks antecedent basis and thus renders the claim indefinite.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9-14 (insofar as claims 9-14 could be understood) are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuroda et al. (of record)

Kuroda et al. (Figs. 1A and 1B) discloses a multi-layer board including: signal conductors (S1-S3) in a dielectric layer (14) (Claim 11 insofar as could be understood); lattice shaped ground patterns (G1 and G2) are on the outsides of the dielectric layer (Claims 12-14 insofar as could be understood) which reduces the maximum deviation of the characteristic impedance of the signal lines (see Col. 3, lines 10-20) and thus inherently affects the signal characteristics.

Note that the limitation of the conductor being changeable is not given any patentable weight since the structure does not appear to be adjustable in its final product state (see the 112 rejections above for details) (Claims 9 and 10).

### ***Response to Arguments***

8. Applicant's arguments filed 6/20/02 have been fully considered but they are not persuasive.

Applicant argues that Kuroda et al. does not teach wherein the earth conductor is on the second area of the dielectric substrate and the position of the earth conductors is changeable.

Applicant's argument is not persuasive because applicant's invention does not appear to be changeable. In an apparatus claim only the final product is patentable. Applicant's final product invention does not appear to include any material adjustment mechanism (see the above rejections for more details).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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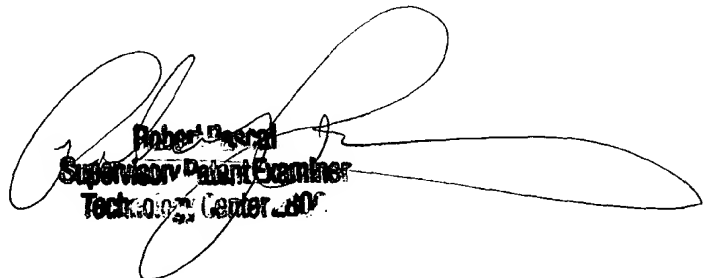
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen E. Jones whose telephone number is 703-305-0390. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on 703-308-4909. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6251 for regular communications and 703-308-6251 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

SEJ  
August 27, 2002

  
Robert J. Pascal  
Supervisor Patent Examiner  
Technology Center 300